

REMARKS

A. Rule 173(c) Statement of Status of Claims and Support for Claim Changes

The status of the claims following entry of the amendment above is: claims 1-9, 11, 12, 14, 50-53, 55, 56, 59-64, 66-72 and 74-78 are pending, and claims 10, 13, 15-49, 54, 57, 58, 65, and 73 are canceled.

Claim 71 has been amended by this paper, and claim 73 has been canceled by this paper.

An explanation for the amendment to claim 71 appears below.

1. Independent Claim 71

The language of claim 71 at the time of the May 11, 2009 Office Action is set forth below, with language added by this amendment shown as underlined:

71. A method of covering wastewater, comprising:

disposing at least two panels over wastewater that includes sewage and/or industrial waste, where the at least two panels are linked to each other and each contains, but is not completely filled with, insulation material sealed inside it.

Support for the addition of the term “sealed” is found in the second sentence of the Abstract of the original patent, and at col. 1, lines 37-39 of the original patent, where the meaning of sealed is explained.

B. Examiner Discussions

On Friday, January 8, 2010, Mark Garrett (Applicants’ representative) called Examiner Canfield to inquire about the status of the outstanding response. Examiner Canfield explained that the Office intended to maintain its rejection of claim 71 and its dependents, but allow the remaining claims. Examiner Canfield inquired whether Applicants would prefer to receive a final Office Action, cancel claims 71-78, or amend claim 71 in a supplemental response to include the “sealed” limitations from some of the other allowed claims.

On Thursday, January 14, 2010, Mr. Garrett called Examiner Canfield with the answer that Applicants would file a supplemental response that amended claim 71 as discussed, but that would also include a statement explaining that the “sealed” language in the claims referred to—as described in the specification—the panels being sealed watertight at their sides/ends, which the Walker and Brock patents both failed to disclose or suggest, and did not require the watertight feature on top of the panels. Examiner Canfield agreed to consider the supplemental response.

C. Meaning of “Sealed”

As inventor Michael A. Morgan notes in his attached Rule 132 declaration, independent claims 5, 50, and 55 all specify “at least two sealed panels.” Claim 56 specifies that insulation material is “sealed inside each panel,” as does claim 71: “sealed inside [each panel].” Claims 60 and 63 each specifies that “each panel includes insulation material sealed inside, but not completely filling, a void in the panel.” January 14, 2010 Rule 132 Declaration of Michael A. Morgan at § 3.

As Mr. Morgan explains, the “sealed” language in these claims refers to the sides and ends of the claimed panels being sealed watertight. *Id.* at § 4. The explanation in the original patent of how the panels are sealed appears at col. 1, lines 37-39, which states: “Each casing **1** is filled with a layer of insulation **3** and then sealed at either end and along either side by a fusion weld **4**.” *Id.* It would have been clear to someone of ordinary skill in the art at the time the original application was filed (in 1993) that those sealed ends and sides are watertight for several reasons:

- It would be very difficult to meet the “primary advantage” of our invention (removing and reusing our linked panels in order to dredge a wastewater pond – col. 1, lines 18-20) if sealed sides and ends of the panels were not watertight

because wastewater would get into the panels through those edges, which are necessarily in or very close to the wastewater, making them heavier and more difficult to move. *Id.* at § 5.

- With regard to the sentence that explains that the grommets described in the patent are positioned outside the welded area so as not to break the seal (col. 2, lines 1-4), no one in this industry would be concerned about breaking a “seal” that was intermittent or otherwise not watertight. So, the only way that sentence makes sense is in reference to a seal that is watertight. Therefore, that is how anyone in this field would have read and understood the claimed seals: as watertight. *Id.* at § 6.
- The advantage specified right after removability in the original patent is insulative (“[a]nother advantage is that the insulation results in heat being retained in the pond” – col. 1, lines 20-22), and that advantage would have been impaired or eliminated if the seals were not watertight because the wastewater would get into the panels through the side(s) and/or end(s) and fill the voids in the insulation, rendering them no longer effective as an insulator. *Id.* at § 7.

Mr. Morgan explains that while he pointed out in his August 17, 2008 declaration that the Walker patent (US 4,590,714) has a vent on top through which air can escape when the tarp is compressed and through which air can enter the tarp when the compressive force is removed, that aspect of Walker is not relevant to the claimed seals because it does not concern the sides and ends of Walker’s tarp; instead, it concerns a separate opening on the top of Walker’s tarp, as described in the first paragraph of column 2 of Walker and shown in Figure 1 of Walker. *Id.* at § 8.

In this same regard, Applicants’ statement on page 13 of the August 18, 2008 response, which points out this fact – “Furthermore, Walker’s tarp includes a vent on its top so that air can escape through the vent as the insulation is compressed for storage, and so that air can enter the tarp when the compressive force is removed and the insulation expands. Morgan Decl. at paragraph 4.” – was unnecessary. The declaration citation and parenthetical explanation of the next sentence of that response – “Thus, Walker’s tarp is not sealed. Morgan Decl. at paragraph 5 (‘the membranes [of Walker’s tarp] are stitched together and not sealed.’)” – make clear and

should be understood as pointing out the relevant difference between the claimed seals and Walker (i.e., Walker's stitched-together seals). Brock also fails to disclose watertight-sealed sides and ends, as the Office noted.

D. Conclusion

Applicants respectfully submit that claims 1-9, 11, 12, 14, 50-53, 55, 56, 59-64, 66-72, and 74-78 are in condition for allowance. Should the Examiner have any questions, comments, or suggestions relating to this application, he is invited to contact the undersigned attorney at (512) 536-3031 to expedite the resolution of any remaining issues.

Date: January 14, 2010

Respectfully submitted,

/Mark T. Garrett/

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